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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,923	04/12/2004	Kazuhiko Oonishi	KATA-190	2125
217	7590	08/28/2006	EXAMINER	
FISHER, CHRISTEN & SABOL 1725 K STREET, N.W. SUITE 1108 WASHINGTON, DC 20006			DOUYON, LORNA M	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/821,923	OONISHI ET AL.	
	Examiner	Art Unit	
	Lorna M. Douyon	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 21-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/25/04; 9/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 12-20, drawn to a coating film-stripping solution, classified in class 510, subclass 201.
 - II. Claims 7-11, 21-41, drawn to a coating-film-stripping method, classified in class 134, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product such as a composition consisting of ethylene glycol monobutyl ether and isopropyl alcohol.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species:
 - a) alkali metals, alkali metal compounds

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b) phosphoric acids, phosphoric acid compounds

c) organic acids and organic acid salts

d) amide compound

The species are independent or distinct because each species are different compounds.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. During a telephone conversation with Virgil Marsh on August 16, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 12-20, Species (a) alkali metals, alkali metal compounds. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11, 21-41 have withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

7. Claims 1-6, 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite in the recital of “alkali metals” because these metals are not normally used in their metal forms. Does Applicant mean “alkali metal compounds?” It is suggested that “alkali metals” be deleted inasmuch as “alkali metal compounds” is already claimed.

Claims 2-6, 12-20, being dependent upon claim 1, are rejected as well.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-5, 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kataoka (US Patent No. 4,518,675).

Kataoka teaches a stripper for a radiosensitive resist (see abstract) which consists of a 5% solution of ethoxysodium (sodium ethoxide) in ethanol (see Example 6, col. 4, lines 22-23).

Kataoka teaches the limitations of the instant claims. Hence, Kataoka anticipates the claims.

10. Claims 1-2, 4-5, 12, 14, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Harelstad (US Patent No. 5,073,287).

Harelstad teaches a paint stripper and/or organic coating remover composition which is formulated as follows: 5% by weight sodium methoxide, 15% by weight methyl alcohol and 80% by weight N-methyl-2-pyrrolidone (see Example 1, col. 4, lines 17-25). Harelstad teaches the limitations of the instant claims. Hence, Harelstad anticipates the claims.

11. Claims 1, 4, 5, 6 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sim (US Patent No. 5,411,678).

Sim teaches a paint-stripper composition comprising 30 wt% benzyl alcohol (equivalent to solvent A); 3 wt% pyrrole (equivalent to solvent B); 0.2 wt% sodium silicate and 0.1 wt% sodium hydroxide (both being alkali metal compounds), see Example 5, col. 6, lines 56-67. See also Examples 6-13 under cols. 7-8. Sim teaches the limitations of the instant claims. Hence, Sim anticipates the claims.

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12. Claims 1, 4, 5, 6 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Nercissiantz et al. (EP 0,903,381), hereinafter "Nercissiantz".

Nercissiantz teaches a paint-stripper composition comprising 19.45 wt% benzyl alcohol (equivalent to solvent A); 1.5 wt% pyrrole (equivalent to solvent B); 3.00 wt% sodium silicate and 0.25 wt% sodium hydroxide (both being alkali metal compounds), see Example IV on page 10, lines 1-29. Nercissiantz teaches the limitations of the instant claims. Hence, Nercissiantz anticipates the claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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15. Claims 2, 3, 12-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sim as applied to the above claims.

Sim teaches the features as described above. In addition, Sim teaches that alkalinity agents can also be incorporated into the paint-stripping composition such as sodium ethoxide to neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. (see col. 5, lines 21-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate sodium ethoxide into the paint-stripping composition because this would neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. as taught by Sim.

16. Claims 2, 3, 12-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nercissiantz as applied to the above claims.

Nercissiantz teaches the features as described above. In addition, Nercissiantz teaches that alkalinity agents can also be incorporated into the paint-stripping composition such as sodium ethoxide to neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. (see page 6, line 56 to page 7, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate sodium ethoxide into the paint-stripping composition because this would neutralize the acidity contributed by some components such as inhibitors, thickeners, surfactants, etc. as taught by Nercissiantz.

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17. Claims 3, 6, 13, 15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harelstad as applied to the above claims in view of Sim.

Harelstad teaches the features as described above. Harelstad, however, fails to specifically disclose sodium ethoxide, and a mixed solvent of a solvent A having a water-solubility of 5% by weight or more with a solvent B having a water-solubility less than 5% by weight.

Sim, in an analogous art, teaches the equivalency of sodium methoxide and sodium ethoxide (see col. 5, lines 25-27), and also teaches a mixed solvent comprising benzyl alcohol and pyrrole (which meets the water-solubility requirements of solvent A and B, respectively), see col. 6, lines 56-67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute sodium methoxide with sodium ethoxide because the substitution of art recognized equivalents as shown by Sim is within the level of ordinary skill in the art, and to incorporate benzyl alcohol and pyrrole into the composition because it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, see *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

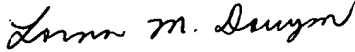
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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is (571) 272-1313.

The examiner can normally be reached on Mondays-Fridays from 8:00AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Lorna M. Douyon
Primary Examiner
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